

REMARKS:

In his action dated November 5, 1996, the Examiner has sustained his rejection of Claims 1, 2, 12 and 18 under 35 U.S.C. § 103 as being unpatentable over *Yamazaki*, Japanese Patent Application Laid-Open 4-205852. That rejection is once respectfully traversed.

Yamazaki, as accurately portrayed by the Examiner, discloses an invention in which a data storage system having a solid state cache memory and a storage element uses a control system to access data stored within the cache if the data is present within the cache and operates the storage element at a low power level in that situation. If the data required is not present within the cache, the storage element is brought up to operational power levels and the data is thereafter retrieved from the storage element.

The Examiner takes the position that *Yamazaki* also "inherently teaches a means for designating selected data within the cache as new data in response to a write from the computer which updates data within the cache because Yamazaki manages write requests..."

Applicant has carefully examined *Yamazaki* in its entirety and fails to find even the slightest suggestion within *Yamazaki* for the process of writing data into the cache. *Yamazaki* is entirely and completely directed to the concept of reading data from either the storage element or the cache and Applicant has yet to find a single reference therein for writing data into the cache.

Further, the Examiner notes "*Yamazaki* therefore differs from the claimed invention by not specifically teaching a cache replacement mechanism which flushes dirty entries when another disk transaction requires access to the disk itself ..." Applicant would respectfully point out to the Examiner that a "dirty" entry within a cache represents data which is no longer valid. Such data is

typically "flushed" in that it is removed from the cache as invalid. In direct contrast, the method and system of the present invention designates data which has been updated within the cache as "new data" and thereafter transfers the new data from the cache memory to the storage element when the storage element is at operating speed as a result of a read or write request which requires an access to the storage element. The manner in which *Yamazaki* does or does not "flush dirty entries" from the cache is, in the opinion of the Applicant, irrelevant to the concept of writing new data from the cache to the storage element as set forth expressly within the presently claimed invention. The Examiner's assertion that "data safety is enhanced by quickly flushing dirty entries", is inaccurate and irrelevant to the present invention.

In summary, Applicant urges the Examiner to consider that the only suggestion for writing updated data to the storage element only when the storage element is placed at operational speed as a result of a read or write request from the host which cannot be satisfied by the cache comes from the Applicant's own specification and Applicant urges that the Examiner has engaged in impermissible hindsight in asserting the suggestion of this technique within the *Yamazaki* reference. Consequently, Applicant urges that the Examiner's rejection of Claims 1, 2, 12 and 18 under 35 U.S.C. § 103 as unpatentable over *Yamazaki* is not well founded and withdrawal of that rejection is respectfully requested.

Once again, the Examiner has also rejected Claims 3, 10 and 11-17 over the *Yamazaki* reference in combination with various secondary references. None of these secondary references show or suggest in any way the method and system of the present invention which accesses data within a cache if the read or write request from the host can be satisfied by an access to the cache and thereafter designates data within the cache as new data in response to a write request from the computer which updates that data and which further thereafter replaces the data within the system storage element with the new data only after the storage element is brought to operating speed as a result of a read or write request which requires an access to the storage element in the manner set forth

within the present claims. No combination of these references, whether considered alone or in combination with *Yamazaki*, can be said to show or suggest this novel invention and withdrawal of the various rejections is respectfully requested.

No extension of time is believed to be required; however, in the event that an extension of time is required, please consider that extension requested and please charge the fee for that extension, as well as any other fee necessary to further the prosecution of this application to Deposit Account No. 09-0465.

Respectfully submitted,



Andrew J. Dillon
Registration No. 29,634
FELSMAN, BRADLEY, GUNTER
& DILLON, LLP
Suite 350 Arboretum Point
9505 Arboretum Boulevard
Austin, Texas 78759
512.343.6116
ATTORNEY FOR APPLICANTS